



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,476	06/28/2001	Andrew Comas	72167.000564	5938
21967 7590 09/17/2007 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER GRAHAM, CLEMENT B	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 09/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/894,476	Applicant(s) COMAS ET AL.	
	Examiner Clement B. Graham	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-12 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3692

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 6/25/07 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-9, do not recite any structure or functionality to suggest that a computer performs the recited claims. Thus, claims 1-9, are rejected as being directed to non-statutory subject matter.

Applicant's is advised to imbed a computer in the body of the claims.

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12, are rejected under 35 U.S.C. 102(b) as being anticipated by Townsend U.S Patent 6, 374, 358).

As per claim 1, Townsend discloses a computer implemented method for structured development of migration options in a legacy transactional enterprise, the method comprising:

identifying components of the legacy enterprise;

developing risk factors for the components of the legacy enterprise; identifying unmet opportunities;

developing risk factors for the unmet opportunities; identifying potential

components for the legacy enterprise (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) developing risk

factors for the potential components of the legacy enterprise; developing by a

computer the migration options with associated risks using at least the risk

factors for the components, the risk factors for the unmet opportunities and the

risk factors for the potential components and providing by a computer the

migration options.(Note abstract and (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 2, Townsend discloses wherein the components of the legacy enterprise are selected from the group consisting of hardware or software. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 3, Townsend discloses wherein the unmet opportunities are selected from the group consisting of new hardware, new software or new

Art Unit: 3692

business methods. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 4, Townsend discloses wherein the potential components for the legacy enterprise are selected from the group consisting of hardware or software. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 5, Townsend discloses wherein the potential components for the legacy enterprise include conceptual models of undeveloped capabilities. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 6, Townsend discloses wherein the risk factors include multiple variables. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 7, Townsend discloses wherein the risk factors are selected from the group consisting of cost or schedule. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 8, Townsend discloses wherein the migration options with associated risk factors are selected from the group consisting of existing components or conceptual models of undeveloped capabilities. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 9, Townsend discloses wherein the associated risks of the migration options are derived from the risk factors for the components of the legacy enterprise, the risk factors for the unmet opportunities, and the risk factors for the potential components of the legacy enterprise. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 10, Townsend discloses computer executable software code transmitted as an information signal, the code for structured development of migration options in a legacy transactional enterprise, the code comprising: code to capture identity of components of the legacy enterprise;

Art Unit: 3692

code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67)

code to capture risk factors for the unmet opportunities;

code to capture identity of potential components for the legacy enterprise (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) code to capture risk factors for the potential components of the legacy enterprise;

and code to develop the migration options with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

As per claim 11, Townsend discloses a computer-readable medium having computer executable software code stored thereon, the code for structured development of migration options in a legacy transactional enterprise, the code comprising:

code to capture identity of components of the legacy enterprise;

code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67)

) code to capture risk factors for the unmet opportunities;

code to capture identity of potential components for the legacy enterprise(see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) code to capture risk factors for the potential components of the legacy enterprise, and code to develop the migration options with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components.

(see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

Art Unit: 3692

As per claim 12, Townsend discloses a programmed computer for structured development of migration options in a legacy transactional enterprise, comprising:

a memory having at least one region for storing computer executable program code; and a processor for executing the program code stored in the memory; wherein the program code comprises:

code to capture identity of components of the legacy enterprise (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67)

code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities;

code to capture risk factors for the unmet opportunities(see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67)

code to capture identity of potential components for the legacy enterprise;

code to capture risk factors for the potential components of the legacy enterprise; and code to develop the migration options with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components. (see column 3 lines 17-67 and column 4 lines 1-19 and column 5-6 lines 1-67 and column 10 lines 30-67) .

Conclusion

RESPONSE TO ARGUMENTS

6. In response to Applicant's arguments filed 6/25/2007 has been fully considered but they are moot in view of new grounds of rejections.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone numbers for the organization where this application or proceeding is

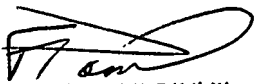
Art Unit: 3692

assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

March 26, 2007


FRANTZY POINVIL
PRIMARY EXAMINER
AU 3692